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Paper No. 12

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In re Application of :
Katsutoshi Ando et al. :
Application No. 10/020,514 :
Filed: December 18, 2001 :
Attorney Docket No. 108421-00030 :
For: Bolt Structure For Use With :
Magnesium Alloy Member For Tightening :
Magnesium Alloy Members With Each :
Other Or With A Heterogeneous Material :

**DECISION ON PETITION TO
ACCEPT COLOR PHOTOGRAPHS
UNDER 37 CFR § 1.84(b)(2)**

This letter is in response to Applicants' Petition filed September 30, 2003, for acceptance of color photographs.

The requirements for the granting of such a petition include:

- i) The fee set forth in § 1.17(h);
- ii) Three sets of color photographs;
- iii) A black and white photocopy that accurately depicts, to the extent possible, the subject matter shown in the color photographs;
- iv) An amendment to the specification to insert (unless the specification contains or has been previously been amended to contain) the language as the first paragraph of the brief description of the drawings: The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.
- v) An explanation as to why the color photographs are necessary per 37 CFR § 1.84(a)(2).

Applicants' petition requesting consideration acceptance of the color photographs satisfies requirements i)-iv) above.

However, Applicant's petition fails to give an explanation as to why the color photographs are necessary. 37 C.F.R. § 1.84(b)(2) requires that all conditions for accepting color drawings and black and white photographs have been satisfied. 37 C.F.R. § 1.84(a)(2) sets forth these conditions:

- (2) Color. On rare occasions, color drawings may be necessary **as the only practical medium by which to disclose the subject matter sought to be patented** in a utility or design patent application or the subject matter of a statutory invention registration. The color drawings must be of sufficient quality such that all details in the drawings are reproducible in black and white in the printed patent. Color drawings are not permitted in international applications (see PCT Rule 11.13), or in an application, or copy thereof, submitted under the Office electronic filing system. The Office will accept color drawings in utility or design patent applications and statutory invention registrations only after granting a petition filed under this paragraph **explaining why the color drawings are necessary**. Any such petition must include the following:
- (i) The fee set forth in § 1.17(h);
 - (ii) Three (3) sets of color drawings;
 - (iii) A black and white photocopy that accurately depicts, to the extent possible, the subject matter shown in the color drawing; and
 - (iv) An amendment to the specification to insert (unless the specification contains or has been previously amended to contain) the following language as the first paragraph of the brief description of the drawings: The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

Applicant's petition fails to give any explanation as to why color photographs are the only practical medium by which to disclose the subject matter sought to be patented, thus, failing to explain why the color photographs are necessary.

Accordingly, the petition is **Dismissed**.



Lynne Browne
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